

Appl. No.: 10/572,710
Reply to Notice of: 09/17/2010

REMARKS

This amendment is filed concurrently with a Request for Continued Examination (RCE). This amendment is in response to the Notice of Panel Decision from Pre-Appeal Brief Review mailed on 09/17/2010 and also addresses the office action mailed 04/29/2010.

By way of background, Applicants filed a Response to Final Office Action on 06/22/2010. The Advisory Action (mailed 07/20/2010) substantively maintained the rejections of the afore-referenced Final Office Action. Accordingly, Applicants filed a Notice of Appeal concurrently with a Pre-Appeal Brief Request for Review on 07/29/2010. In a Notice of Panel Decision from Pre-Appeal Brief Review dated 09/17/2010, the Panel indicated that claims remain rejected.

Claims 1-9, 11, and 13-26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kaplan (US 6,690,358) in view of Salmi et al. (US 7,158,626). Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kaplan (US 6,690,358) in view of Salmi et al. (US 7,158,626) and Kalinski et al. (US 2003/0174307). The examiner is requested to reconsider these rejections.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Claim 1 has been amended above to clarify applicants' claimed invention. Claim 1 recites, *inter alia*, "wherein the mobile

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cellular telephone is configured to be useable as a practical tool". Support for this amendment may be found, for example, on page 1, lines 16 and 17.

Various exemplary embodiments of the invention relate to a mobile cellular telephone 10 which includes an incline sensor 16 that is arranged to detect an inclination of the mobile telephone 10. The mobile telephone 10 also includes a processor 12 which is arranged to receive signals from the incline sensor 16. When the mobile telephone 10 is placed in an inclinometer mode (i.e. a mode where the telephone acts as an instrument for enabling a user to measure the inclination of the mobile telephone) the processor 12 receives signals from the incline sensor 16 and controls a display 14 to display an item whose position is dependent upon the inclination measured by the incline sensor 16. As mentioned on page 4, lines 9 to 13 the mobile telephone can emulate a spirit level and thereby enable a user to measure the inclination of a surface (please see page 5, lines 15 to 34). Consequently, the mobile cellular telephone is configured to be useable as a practical tool (please see page 1, lines 16 and 17).

In contrast, Kaplan relates to cursor control in a display of a hand-held device (column 1, lines 1 to 2). Kaplan discloses a special orientation sensor within a device which provides for movement of a screen cursor in response to changes in the spatial orientation of the device (abstract).

Kaplan specifically discloses a Portable Digital Assistant (PDA) 100 that includes a screen 110, activation buttons 12,

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13, 14 and accelerometers 10, 11. The screen 110 may display a cursor 120 and pushing one or more of the buttons 12, 13, 14 may enable movement of the cursor 120 about the screen 110. The accelerometers 10, 11 provide an output signal that is related to the angle of the accelerometers' major axis away from a horizontal plane when the PDA is in a "neutral position". The output signal of the accelerometer 10, 11 is received and processed by the processor 17 which may control the screen 110 accordingly.

The "neutral position" is described in Kaplan at column 2, lines 46 to 55 as "when PDA 100 is held in a position that is tilted upwards to facilitate viewing of screen 100, say 30 degrees above the horizon".

If button 13 is pushed, the cursor 120 becomes responsive to the orientation of the PDA 100.

If button 14 is pressed, the processor 17 may use the accelerometer 10, 11 output signal to control the panning of an image displayed on the screen 110 (as opposed to controlling the cursor).

Thus, Kaplan merely discloses a sensor within a device which provides for movement of a screen cursor in response to changes in the spatial orientation of the device. There is no disclosure in Kaplan that the device is configured to be useable as a practical tool.

Salmi discloses a communications terminal 100 for a trunked radio network such as Tetra. As illustrated in fig. 6, the terminal 100 includes a display 121 that may display a scroll

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bar 62. The scroll bar 62 can be used to indicate to the user of the calling terminal that more selections can be viewed than the one presently shown on the display 121 (please see col. 7, lines 7 to 9).

Salmi merely discloses that a scroll bar 62 can be used to indicate to the user of the calling terminal that more selections can be viewed than the one presently shown on the display 121. There is no disclosure that the terminal of Salmi is configured to be useable as a practical tool.

Various embodiments of the present invention provide an advantage in that the mobile cellular telephone may be used as a practical tool. According to one definition of "tool" from <http://dictionary.reference.com/browse/tool>, a "tool" is an implement, esp. one held in the hand ... for performing or facilitating mechanical operations". Consequently, various embodiments may be useful to a builder (for example) since the mobile cellular telephone may be used instead of a traditional spirit level and may enable the builder to carry less tools when working.

Applicants submit that there is no suggestion to combine the references as the examiner is attempting to do (at least not until after reading applicants' patent application). In particular, it would not be obvious to a person skilled in the art to adapt the teaching of Kaplan to fall within the scope of attached claim 1. Kaplan is concerned with providing a graphical user interface whereby a user may control a screen cursor by changing the orientation of the device. The screen cursor is clearly provided for enabling a user to provide an

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input to the graphical user interface (please see col.1, lines 7 to 46 which describe the background of the invention in Kaplan). Kaplan does not teach or suggest using cursor control to facilitate a mechanical operation and is consequently not concerned with providing a practical tool. There is no teaching in Kaplan that would motivate a skilled person to adapt the device of Kaplan so that it is configured to be useable as a practical tool.

Furthermore, even if, for the sake of argument, Kaplan and Salmi were combined as proposed by the examiner, the resulting device would not fall within the scope of claim 1. For example, if the cursor of Kaplan was placed in the scroll bar 62 of Salmi, the resulting device would not include the feature of the position of the item within the bar representative (or provides an indication) of the inclination (or incline) of the mobile telephone, as recited in the claims. As mentioned above, the scroll bar 62 of Salmi is used to indicate to the user of the calling terminal that more selections can be viewed than the one presently shown on the display 121. If the cursor of Kaplan was placed in the scroll bar 62 of Salmi, a change in inclination would result in a different selection being displayed on the display and the position of the cursor in the scroll bar 62 would not indicate the sense and amount of inclination, but rather the position of the displayed content within the overall content.

Therefore, it would not be obvious to adapt Kaplan to display "a bar and an item, at a position within the bar dependent upon the received indication, the position of the item within the bar representative of the sense and amount of inclination

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of the mobile cellular telephone in the first plane, wherein the display has a first area and the bar has a second area" as recited in claim 1.

Applicants additionally submit that it would not be obvious to a person skilled in the art to combine the teachings of Kaplan and Salmi because such a combination would go against the teaching of Kaplan. As mentioned above, Kaplan clearly teaches providing a screen cursor for enabling a user to provide an input to the graphical user interface. Applicants' respectfully submit that the examiner's broad interpretation of a cursor is clearly incorrect given the background of invention section of Kaplan. A person skilled in the art would not place the cursor of Kaplan in a bar as recited in claim 1 since it would restrict the movement of the cursor and could result in sections of the display being inaccessible to the user. Any such combination (such as Kaplan in view of Salmi as proposed by the examiner) would therefore result in a device with poor cursor control which is clearly contrary to the teaching of Kaplan.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. (see MPEP 2143.01, page 2100-98, column 1). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (see MPEP 2143.01, page 2100-98, column 2). A statement that

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modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. (see MPEP 2143.01, page 2100-99, column 1) Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). >See also Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.)

In the present case, there is no teaching, suggestion, or motivation, found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to provide a mobile cellular telephone comprising ... a processor configured to ... control the display to display, to a user of the mobile cellular telephone, a bar and an item, at a position within the bar dependent upon the received indication, the position of the item within the bar representative of the sense and amount of inclination of the mobile cellular telephone in the first plane, wherein the display has a first area and the bar has a second area, the second area being smaller than the first area, and wherein the mobile cellular telephone is configured to be useable as a practical tool, as claimed in claim 1. The features of claim 1 are not disclosed or suggested in the art of record. Therefore, claim 1 is patentable and should be allowed.

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Though dependent claims 2-10, 13, 14, 24, 27 and 28 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 1. However, to expedite prosecution at this time, no further comment will be made.

Claim 11 has been amended above to clarify applicants' claimed invention. Claim 11 recites, *inter alia*, "wherein the mobile cellular telephone is configured to be useable as a practical tool".

Similar to the arguments presented above with respect to claim 1, Kaplan merely discloses a sensor within a device which provides for movement of a screen cursor in response to changes in the spatial orientation of the device. There is no disclosure in Kaplan that the device is configured to be useable as a practical tool. Salmi merely discloses that a scroll bar 62 can be used to indicate to the user of the calling terminal that more selections can be viewed than the one presently shown on the display 121. There is no disclosure that the terminal of Salmi is configured to be useable as a practical tool.

Additionally, applicants submit that there is no suggestion to combine the references as the examiner is attempting to do (at least not until after reading applicants' patent application). In particular, it would not be obvious to a person skilled in the art to adapt the teaching of Kaplan to fall within the scope of attached claim 11. Kaplan is concerned with providing a graphical user interface whereby a user may control a screen cursor by changing the orientation of the

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device. The screen cursor is clearly provided for enabling a user to provide an input to the graphical user interface (please see col.1, lines 7 to 46 which describe the background of the invention in Kaplan). Kaplan does not teach or suggest using cursor control to facilitate a mechanical operation and is consequently not concerned with providing a practical tool. There is no teaching in Kaplan that would motivate a skilled person to adapt the device of Kaplan so that it is configured to be useable as a practical tool.

In the present case, there is no teaching, suggestion, or motivation, found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to provide the features of claim 11. Therefore, claim 11 is patentable and should be allowed.

Claim 15 has been amended above to clarify applicants' claimed invention. Claim 15 recites, *inter alia*, "wherein the mobile cellular telephone is configured to be useable as a practical tool".

Similar to the arguments presented above with respect to claim 1, Kaplan merely discloses a sensor within a device which provides for movement of a screen cursor in response to changes in the spatial orientation of the device. There is no disclosure in Kaplan that the device is configured to be useable as a practical tool. Salmi merely discloses that a scroll bar 62 can be used to indicate to the user of the calling terminal that more selections can be viewed than the one presently shown on the display 121. There is no

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disclosure that the terminal of Salmi is configured to be useable as a practical tool.

Additionally, applicants submit that there is no suggestion to combine the references as the examiner is attempting to do (at least not until after reading applicants' patent application). In particular, it would not be obvious to a person skilled in the art to adapt the teaching of Kaplan to fall within the scope of attached claim 15. Kaplan is concerned with providing a graphical user interface whereby a user may control a screen cursor by changing the orientation of the device. The screen cursor is clearly provided for enabling a user to provide an input to the graphical user interface (please see col.1, lines 7 to 46 which describe the background of the invention in Kaplan). Kaplan does not teach or suggest using cursor control to facilitate a mechanical operation and is consequently not concerned with providing a practical tool. There is no teaching in Kaplan that would motivate a skilled person to adapt the device of Kaplan so that it is configured to be useable as a practical tool.

In the present case, there is no teaching, suggestion, or motivation, found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to provide the features of claim 15. Therefore, claim 15 is patentable and should be allowed.

Though dependent claims 16-23 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 15. However, to

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expedite prosecution at this time, no further comment will be made.

Claim 25 has been amended above to clarify applicants' claimed invention. Claim 25 recites, *inter alia*, "wherein the mobile cellular telephone is configured to be useable as a practical tool".

Similar to the arguments presented above with respect to claim 1, Kaplan merely discloses a sensor within a device which provides for movement of a screen cursor in response to changes in the spatial orientation of the device. There is no disclosure in Kaplan that the device is configured to be useable as a practical tool. Salmi merely discloses that a scroll bar 62 can be used to indicate to the user of the calling terminal that more selections can be viewed than the one presently shown on the display 121. There is no disclosure that the terminal of Salmi is configured to be useable as a practical tool.

Additionally, applicants submit that there is no suggestion to combine the references as the examiner is attempting to do (at least not until after reading applicants' patent application). In particular, it would not be obvious to a person skilled in the art to adapt the teaching of Kaplan to fall within the scope of attached claim 25. Kaplan is concerned with providing a graphical user interface whereby a user may control a screen cursor by changing the orientation of the device. The screen cursor is clearly provided for enabling a user to provide an input to the graphical user interface (please see col.1, lines 7 to 46 which describe the background

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of the invention in Kaplan). Kaplan does not teach or suggest using cursor control to facilitate a mechanical operation and is consequently not concerned with providing a practical tool. There is no teaching in Kaplan that would motivate a skilled person to adapt the device of Kaplan so that it is configured to be useable as a practical tool.

In the present case, there is no teaching, suggestion, or motivation, found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to provide the features of claim 25. Therefore, claim 25 is patentable and should be allowed.

Claim 26 has been amended above to clarify applicants' claimed invention. Claim 26 recites, *inter alia*, "wherein the mobile cellular telephone is configured to be useable as a practical tool".

Similar to the arguments presented above with respect to claim 1, Kaplan merely discloses a sensor within a device which provides for movement of a screen cursor in response to changes in the spatial orientation of the device. There is no disclosure in Kaplan that the device is configured to be useable as a practical tool. Salmi merely discloses that a scroll bar 62 can be used to indicate to the user of the calling terminal that more selections can be viewed than the one presently shown on the display 121. There is no disclosure that the terminal of Salmi is configured to be useable as a practical tool.

Additionally, applicants submit that there is no suggestion to combine the references as the examiner is attempting to do (at

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least not until after reading applicants' patent application). In particular, it would not be obvious to a person skilled in the art to adapt the teaching of Kaplan to fall within the scope of attached claim 26. Kaplan is concerned with providing a graphical user interface whereby a user may control a screen cursor by changing the orientation of the device. The screen cursor is clearly provided for enabling a user to provide an input to the graphical user interface (please see col.1, lines 7 to 46 which describe the background of the invention in Kaplan). Kaplan does not teach or suggest using cursor control to facilitate a mechanical operation and is consequently not concerned with providing a practical tool. There is no teaching in Kaplan that would motivate a skilled person to adapt the device of Kaplan so that it is configured to be useable as a practical tool.

In the present case, there is no teaching, suggestion, or motivation, found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to provide the features of claim 26. Therefore, claim 26 is patentable and should be allowed.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record. Accordingly, favorable reconsideration and allowance is respectfully requested. If there are any additional charges with respect to this Amendment or otherwise, please charge deposit account 50-1924 for any fee deficiency. Should any unresolved issue remain, the examiner is invited to call applicants' attorney at the telephone number indicated below.

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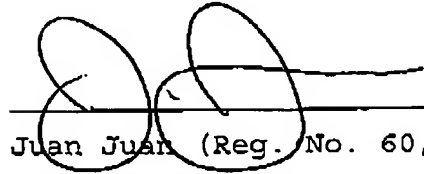
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Respectfully submitted,



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11/17/2010
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